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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,745	06/23/2008	Martin Alles	GRA26 028US	8764
79172	7590	04/26/2010	EXAMINER	
Duane Morris LLP 505 9th Street, N.W. Suite 1000 Washington, DC 20004			LEE, JOHN J	
			ART UNIT	PAPER NUMBER
			2618	
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			04/26/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,745	Applicant(s) ALLES ET AL.	
	Examiner JOHN LEE	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 19-34 is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14 - 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17 - 21 of copending Application No. 10/586,744. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 17 - 21 of copending Application No. 10/586,744 encompasses the limitations of claims 14 - 18 of instant application. Moreover, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. It is well settled that the omission of an element and its functions is an obvious expedient if the remaining elements performs

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the same function as before In re Karison, 163 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969).

More specifically, the independent claim 17 of the copending Application No. 10/586,744 is the same elements, same function, and same result as claim 14 of the present application.

Furthermore, the dependent claims 15 - 18 of the present application are the same elements as claims 18 - 21 of the copending Application No. 10/586,744.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. In addition, Claims 14 - 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10 - 12, 14, and 16 of copending Application No. 10/566,589. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 10 - 12, 14, and 16 of copending Application No. 10/566,589 encompasses the limitations of claims 14 - 18 of instant application. Moreover, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. It is well settled that the omission of an element and its functions is an obvious expedient if the remaining elements performs the same function as before In re Karison, 163 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969).

More specifically, the independent claim 10 of the copending Application No. 10/586,744 is the same elements, same function, and same result as claim 14 of the present application.

Furthermore, the dependents claims 15 - 18 of the present application are the same elements as claims 11, 12, 14, and 16 of the copending Application No. 10/586,744.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 14 – 18** are rejected under 35 U.S.C. 102(b) as being anticipated by Durrant et al. (US 6,501,955).

Regarding **claim 14**, Durrant teaches that in a communication system (Fig.1) including a first node (base station or mobile station), a second node (base station or mobile station), and a repeater (20), wherein the first node receives a first signal from the second node either directly or via the repeater (Fig. 1 and column 4, lines 12 – column 5, lines 52), a method of applying a known distortion to a signal to enable a determination of a signal received by the first node is received directly from the second node or indirectly through the repeater (Fig. 1, 2, column 3, lines 2 – 37, and column 4, lines 12 – column 5, lines 52). Durrant teaches that at the repeater receiving a primary signal and creating a secondary signal (Fig. 2 teaches receiving primary signal (from the base station) and creating and transmitting secondary signal (in repeater and transmitting to

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mobile station) to mobile stations) as a function of the primary signal and a known distortion (known distortion in Fig. 2), wherein the known distortion identifies the repeater (Fig. 2, 3, column 6, lines 15 – 26, column 7, lines 36 – 47, and column 4, lines 12 – column 5, lines 52 as tagging which corresponds to the signal). Durrant teaches that transmitting the primary signal injected with the secondary signal as the first signal (transmitting tagged signal to receiver) to the primary receiver (Fig. 2, 3, column 5, lines 10 – 35, column 6, lines 15 – 26, and column 7, lines 35 – 47).

Regarding **claim 15**, Durrant teaches that the communication system is a wireless communication system (column 1, lines 15 – 65 and Fig. 1 teaches a wireless communication system).

Regarding **claim 16**, Durrant teaches that the primary receiver is a network analysis system (Fig. 4 and column 9, lines 55 – column 10, lines 20, where teaches location measuring base station corresponds to the claimed network analysis system).

Regarding **claim 17**, Durrant teaches that the second node is a mobile unit (Fig. 1, column 4, lines 12 – 60, and column 9, lines 56 – column 10, lines 12, where teaches second node is a mobile unit).

Regarding **claim 18**, Durrant teaches that the secondary signal is transmitted 9 db or less than the primary signal (column 3, lines 3 – 37 and Fig. 1, 2, where teaches tagged signal could be uplink or downlink).

Allowable Subject Matter

6. Claims 1-13 and 19-34 are allowed.

Claims 1-13 and 19-34 are allowable over the prior art of record because a search does not detect the combined claimed elements as set forth in the claims 1-13 and 19-34.

As recited in independent claims 1 and 19, none of the prior art of record teaches or fairly suggests that a primary receiver, a primary transmitter, and a repeater that applies a known distortion to a primary signal passing there through that identifies the repeater, where the primary receiver receives a first signal from the primary transmitter either directly or via the repeater, and where the first signal includes a primary signal and, if the first signal is received from the repeater, also includes a secondary signal that is a function of the primary signal and the known distortion applied by the repeater, the method of determining if a signal received by the primary receiver is received directly from the primary transmitter or indirectly through the repeater, comprising the steps of receiving the first signal at the primary receiver, outputting the primary signal from the primary receiver, receiving the first signal at a secondary receiver and obtaining the primary signal from the primary receiver, applying an inverse function to the first signal and the primary signal to retrieve a distortion, and determining whether the first signal has been received from the repeater by comparison of the distortion and known distortions, and together with combination of other element as set forth in the claims 1-13 and 19-34. Therefore, claims 1-13 and 19-34 are allowable over the prior art of records.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baker et al. (US 7,062,224) discloses Identifying and Monitoring Repeater Traffic in a Code Division Multiple Access System.

Soliman (US 7,295,808) discloses Method and System for Calibrating a Repeater.

Information regarding...Patent Application Information Retrieval (PAIR) system... at 866-217-9197 (toll-free)."

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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Or P.O. Box 1450
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or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(571) 272-7880**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Maung**, can be reached on **(571) 272-7882**. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L

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April 21, 2010

John J Lee

/JOHN LEE/
Primary Examiner, Art Unit 2618